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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

DEGA, MURALI K

ART UNIT	PAPER NUMBER
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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,415	Applicant(s) BOURIANT ET AL.	
	Examiner Murali K. Dega	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) 1-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 50-67 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 68-98 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040624</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 50-67, drawn to an automated electrical financial or business practice or management system for accounting, classified in class 705, subclass 059.
 - II. Claims 68-85, drawn to a method of business or management comprising generic or non-electrical computing, classified in class 705, subclass 500.
 - III. Claims 86-98, drawn to non-statutory subject matter rejected under 35 U.S.C 101.
2. Invention I is related to Invention II as process and apparatus for its practice. The inventions are distinct if it can be shown that *either*: (1) the process as claimed can be practiced by another, materially different apparatus, or by hand, *or* (2) the apparatus as claimed can be used to practice another, materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another, materially different apparatus, or by hand, such as by performing at least some of the recited method steps by hand/manually.
3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

4. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 C.F.R. §1.143) **and (ii) identification of the claims encompassing the elected invention.**

5. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 C.F.R. §1.144. If claims are added after

Art Unit: 3621

the election, Applicant must indicate which of these claims are readable on the elected invention.

6. If claims are added after the election, Applicant must indicate which of these claims are readable upon the elected invention.

7. Should Applicant traverse on the ground that the inventions are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

8. During a telephone conversation with John Musone (Reg. No. 44,961), attorney for Applicant, on March 13, 2008, a provisional election was made without traverse to prosecute the invention I, claims 50-67. **Affirmation of this election must be made by applicant in replying to this Office action.** Claims 68-98 are withdrawn from further consideration by Examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3621

10. Claim 67 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 67 recites the limitation "web licensing service" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 50-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck et al. (US 2003/0172034), in view of Eng (US 2002/0169725).

14. With respect to claim 50:

15. Schneck discloses a system for the graduated, usage-equivalent licensing (*"A user is provided controlled access to the distributed data only in accordance with the rules as enforced by a mechanism protected by tamper protection"*, Abstract) of multifunctional and/or expandable software products, comprising:

a. A first mechanism for detecting functionality used and for comparing (*"If the current data element is determined not to be in the body of the data (step S408), the distributor then determines if the current data element is access rules*

provided by the data owner”, ¶ [0108]) this with already licensed functionality of a software product.

b. a second mechanism for providing information regarding functionality used but not yet licensed (*“If the current data element (being processed) is not access rules, the distributor determines whether or not it is ancillary information (step S424). This information includes such things as the identification of the publisher and the like”, ¶ [0109]*).

c. a third mechanism for generating time-limited authorization to use functionality not yet licensed (*“output permission list in the rules would specify “n copies, only valid for 15 minutes from x to x+15”, ¶ [0261]*).

d. a fourth mechanism for generating an order and/or a request for an offer to a licensor (*“At each point where the developer requires authorization, the executable software requests a permission-check”, ¶ [0291]*).

e. a fifth mechanism for creating a license by the licensor (*“If the requisite authorization is received, the function of the software is performed”, ¶ [0291]*).

f. a sixth mechanism for permanently-authorizing use of the functionality licensed by the system (*“The certificate is issued by an authorized Certification Authority”, ¶ [0184]*).

16. With respect to claim 51:

17. Schneck discloses wherein the system is adapted for the graduated licensing of a standard framework, wherein the standard framework serving to integrate software applications for a production process based on application-specific adapters (*“this*

Art Unit: 3621

control program is considered the application, and all access to controlled data is initiated by the control program which invokes the access mechanism 114”, ¶ [0146]).

18. With respect to claim 52:

19. Schneck discloses wherein the first mechanism is adapted for detecting a new instance (*“If this is the first time the access mechanism is processing rules for this data set... determined whether these are the first rules being processed for this data set” ¶ [0119]*) of the software product or the standard framework.

20. With respect to claim 53:

21. Schneck discloses wherein the first mechanism is adapted for detecting the use of an adapter base (*“the data are being accessed by an application via an insecure operating system (OS) which invokes the access mechanism 114”, ¶ [0146]*) of the software product or the standard framework (The standard operating system being the standard framework).

22. With respect to claim 54:

23. Schneck discloses wherein the first mechanism is adapted for detecting the expansion (*“If the current data element is determined not to be in the body of the data (step S408), the distributor then determines if the current data element is access rules provided by the data owner”, ¶ [0108]*) of the functionality of the software product or the standard framework

24. With respect to claim 55:

25. Schneck discloses wherein the second mechanism is adapted for informing a user by a dialog window about functionality used by said user but not yet licensed and

Art Unit: 3621

to request said user to obtain a license for the functionality used (*"If the current data element (being processed) is not access rules, the distributor determines whether or not it is ancillary information (step S424). This information includes such things as the identification of the publisher and the like", ¶ [0109]*).

26. With respect to claim 56:

27. Schneck discloses wherein the third mechanism is adapted for issuing a provisional license for a period of time needed for handling the order and for generating and installing a permanently valid license (*"output permission list in the rules would specify "n copies, only valid for 15 minutes from x to x+15", ¶ [0261]*).

28. With respect to claim 57:

29. Schneck discloses wherein the fourth mechanism is adapted for e-mailing the licensor an order for the granting of a license (*"A software program (or electronic mail message) may request that a receipt be issued whenever it is loaded or executed", ¶ [0315]*).

30. With respect to claim 58:

31. Schneck discloses wherein a customer-specific account has been provided for automatically debiting (*"Others employ a prepaid balance which is debited", ¶ [0190]*) the license fee due following receipt of an e-mailed order.

32. With respect to claim 59:

33. Schneck discloses wherein a card on which a pre-paid amount is registered is provided as the customer account (*"uses virtual credit cards to provide secure transactions from the Web", ¶ [0189]*).

Art Unit: 3621

34. With respect to claim 60:

35. Schneck discloses wherein the fourth mechanism (*“invention controls secondary distribution and creation of derivative works”*, ¶ [0043] and *“secondary distribution or distribution of modifications (derivatives) of data or information is passive. However, the invention's control of executable software capability is active and requires that the executable software developer use the programming interface provided by the system. At each point where the developer requires authorization, the executable software requests a permission-check”*, ¶ [0291]) is adapted for e-mailing the licensor a request for an offer to grant a license.

36. With respect to claim 61:

37. Schneck discloses wherein the fifth mechanism is adapted for granting a license for producing a license key (*“Controlling Secondary Distribution”*, ¶¶ [0248]-[0251] and *“Transmission of (an unencrypted copy of) a derivative work (to a network, to an output device such as a tape or disk, or to a printer or display device or the like) can only be effected when the system, acting under the rules embodied in permission lists created by each of the owners of any intellectual properties used in the derivative work, allows external output”*, ¶ [0265]).

38. With respect to claim 62:

39. Schneck discloses issuing a provisional license for a period of time needed but does not explicitly disclose disabling the new functionality after a specified period of time. However, Eng teaches wherein a seventh mechanism is adapted for disabling (*“a license lockout can be performed upon the expiration of a grace period”*, Abstract and

Art Unit: 3621

“steps of measuring a license grace period and initiating a license lockout if the grace period is exhausted”, ¶ [0012]) the newly used functionality if licensing is not carried out by the licensor within a specified period of time.

40. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have included the system of incremental granting of access based the teachings of Schneck in addition to Eng’s time based temporary granting of permissions that includes disabling the access after the grace period, to ensure proper purchase of license or permissions, which will help enforcement of license rules and improve revenues for the content authors or distributors, with neither undue experimentation nor risk of unexpected results.

41. With respect to claim 63:

42. Schneck discloses wherein the system is adapted for iterative use by a primary user (*“Controlling Use of Executable Software Control of Primary Distributions”, ¶ [0281])* if additional functionality is provided on the basis of the software product or the standard framework by the primary user for secondary users (*“Controlling Distributions of Derivative Works”, ¶¶ [0263]-[0268])*, with-use being effected by generating secondary licenses (*““The rules associated with the parent work determine whether creation of derivative intellectual property is permitted, as well as the inheritance rules for incorporating the rules of the parent into the derivative work by the primary user”, ¶ [0270])*).

43. With respect to claim 64:

Art Unit: 3621

44. Schneck discloses wherein the system is adapted for provisioning a license key function for the primary user for the specifying of a licensing identity by the primary user (*"a decryption key is provided only to authorized users. The key is subsequently used to enable decryption of the information so that it is available to the authorized user(s). It is at this point that the information is subject to manipulation and redistribution without further limitation."*, ¶¶ [0015] and [0026]).

45. With respect to claim 65:

46. Schneck discloses wherein the system is adapted for a flexible scalability of the secondary licenses (*"System IDs/Public keys Other systems to which 147 these rules may be redistributed"*, ¶ [0095] and *"The rules associated with the parent work determine whether creation of derivative intellectual property is permitted, as well as the inheritance rules for incorporating the rules of the parent into the derivative work by the primary user"*, ¶ [0270]).

47. With respect to claim 66:

48. Schneck discloses wherein an eighth mechanism is provided for apportioning the license fees to be paid to the licensor and primary user by the secondary user (*"License fees and restrictions imposed by the owner of a work are inherited by any derivative works"*, ¶ [0265]).

49. With respect to claim 67:

50. Schneck discloses wherein apportioning of the license fees (*"Some electronic payment systems operate in real time by communicating through the Internet"*, ¶ [0190]) is provided via web licensing service.

Examiner's Note

51. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- g. U.S. Patent N: 6,169,976 to Colosso, discloses regulating the use of licensed products in terms of accessing, installing, activating and upgrading.
- h. U.S. Publication No: 2003/0135474 to Circenis, discloses Pay-per-use software system with different license levels number and time based licenses.
- i. U.S. Publication No: 2002/0138441 to Lopatic, discloses regulating the use of software product and individualizing the software for users.

Art Unit: 3621

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M.K.D/
Art Unit No: 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621